

## **REMARKS**

### **I. Status of the Claims**

In the Office Action mailed November 13, 2007, the Examiner rejected claims 2, 4, 13, 15, 17, 24, 26, 30, and 39 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-39 under 35 U.S.C. § 103(a) as being unpatentable over *CD's are Not Risk-Free, So Shop Around*, by the Pittsburgh Post - Gazette (Hereinafter "the *Post Article*") in view of *Harycki et al.* (U.S. Patent Publication No. 2002/0077966).

By this amendment, Applicants amend claims 1, 7, 14, 20, 27, and 33, and cancel claims 13, 26, and 39 without prejudice or disclaimer. However, by amending these claims, Applicants have not acceded to any of the outstanding rejections. To the contrary, Applicants respectfully traverse the rejections contained in the Office Action. Claims 1-12, 14-25, and 27-38 remain pending in this application.

### **II. Rejection of claim 2, 4, 13, 15, 17, 26, 24 [28], 30, and 39 under 35 U.S.C. § 112**

In the Office Action, the Examiner rejected claims 2, 4, 13, 15, 17, 26, 24 [28], 30, and 39 under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner rejected dependent claims 2, 4, 15, 17, 24 [28], and 30, for lacking antecedent basis for the term "an investor."<sup>1</sup> Applicants have amended independent claims 1, 14, and 27, to recite "an investor." In view of these amendments, Applicants respectfully request that the rejection of claims 2, 4, 15, 17, 24 [28], and 30 under 35 U.S.C. § 112, second paragraph be withdrawn. The cancellation of claims 13, 26, and 39 renders the rejection of these claims under 35 U.S.C. § 112 moot.

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<sup>1</sup> Because claim 24 does not recite any of the limitations referenced by the Examiner, Applicants assume the Examiner incorrectly listed claim 24.

**III. Rejection of claims 1-39 under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-12, 14-25, and 27-38 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *See* M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has not demonstrated why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Further, the cited art fails to teach or suggest each and every recitation of claims 1-12, 14-25, and 27-38.

For example, amended independent claim 1 recites a method for providing, to an investor having a first financial instrument a second financial instrument, the method comprising, among other things:

receiving funds associated with the first financial instrument held with a first financial institution, the funds having been reduced by a penalty for closing the first financial instrument and are received at a second financial institution;  
increasing, by the second financial institution, the funds by a first amount based on the reduced funds due to the penalty.

The *Post Article* and *Harycki et al.*, taken individually or in any proper combination, fail to disclose at least these recitations.

As admitted by the Examiner, the *Post Article* fails to disclose the above “increasing” step as recited in independent claim 1. (*Office Action*, p. 3.) In an effort to cure this deficiency, the Examiner relies on *Harycki et al.* Specifically, the Examiner cites to paragraphs 53 and 54 for this alleged teaching. However, nowhere in these paragraphs or in the remainder of *Harycki et al.* is there a teaching or suggestion of

“increasing, by the second financial institution, the funds by a first amount based on the reduced funds due to the penalty,” as recited in claim 1. Instead, *Harycki et al.* discloses providing a user interface to a customer in order to allow the customer to personalize a credit card by adjusting certain predefined variables. (See *Harycki et al.*, ¶¶ 0053 and 0054.) Specifically, “[b]y means of the interdependencies between variable settings the user is able to adjust the characteristics of the credit card to suit his or her preferences without changing his or her profitability to the provider.” (*Id.* at ¶ 0055.) Nowhere does the system of *Harycki et al.* increase funds by a second financial institution, as recited in claim 1.

Accordingly, the *Post Article* and *Harycki et al.* taken individually or in proper combination, fail to teach or suggest all the recitations of independent claim 1. Moreover, the Office Action does not clearly articulate a reason as to why independent claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Applicants thereby respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Independent claims 14 and 27, while of different scope than claim 1, distinguish over the *Post Article* and *Harycki et al.* for at least the same reasons as claim 1. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 14 and 27 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

Dependent claims 1-12, 14-25, and 27-38 are allowable at least for the reasons set forth above in connection with independent claims 1, 14, and 27. Further, these dependent claims recite additional features that are not taught or suggested by the cited

references. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2-12, 15-25, and 28-38 under 35 U.S.C. § 103(a) and the timely allowance of the claims.

**CONCLUSION**

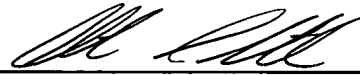
Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims. The preceding remarks are based on the Office Action and, therefore, do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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